

## **REMARKS**

In response to the Notice of Non Compliant Amendment and the Office Action mailed May 10, 2007, each one of the cited references has been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file in the above-identified application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

Claims 39-45 have been withdrawn. Attorney for applicant acknowledges that with respect to the withdrawn claims should a generic independent claim be found to be allowable, the election of species between the elbow, knee, shin and gel material will be added by rejoinder.

In order to render the claims more clear and definite and to emphasize the patentable novelty thereof, claim 36 has been amended and new claim 56 has been added. All claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested.

## **Pending and Withdrawn Claims**

Please note that the examiner has omitted claim 20 from the withdrawn claim list and omitted claim 30 from the pending list. This should be corrected as both claim 20 and 30 are pending and have been withdrawn from consideration.

Attorney for applicant has reviewed the file history for the present case and provides the following information relative to claim status:

### **A. Original Filing and Preliminary**

Application 10/695,223 was filed on October 27, 2003, with 2 independent claims (claims 1-2) and 10 dependent claims (3-12) along with a Preliminary Amendment which amended claims 1-4-5, cancelled claims 2-3, 6-12 and added new dependent claims 13-21.

Based on the foregoing, claims 1, 4-5, and 13-21 are now pending which is inclusive of 1 independent claim (claim 1) and 11 dependent claims (claims 4-5, 13-21), where claims 2-3 and 6-12 have been cancelled.

## **B. Restriction Requirement**

On December 18, 2004, in response to a restriction requirement, applicant elected to prosecute claims 1, 5, 13-18 and 21.

Based on the foregoing, claims 1, 4-5, and 13-21 are now pending which is inclusive of 1 independent claim (claim 1) and 11 dependent claims (claims 5, 13-21), where claims 4, 19-20 are withdrawn dependent claims, and where claims 2-3 and 6-12 have been previously cancelled.

## **C. First Non Final Amendment**

On June 17, 2005 in response to a Official Action, applicant filed an Amendment amending claims 1, 5, 13-18 and 21, adding new dependent claims 22-29 and new independent claim 30 and new dependent claim 31.

Based on the foregoing, claims 1, 4-5, and 13-31 are now pending which is inclusive of 2 independent claim (claims 1 and 30) and 20 dependent claims (claims 4-5, 13-31), where claims 4, 19-20 are withdrawn dependent claims, and where claims 2-3 and 6-12 have been previously cancelled.

## **D. RCE Amendment After Final Rejection**

On November 27, 2005 in response to a Final Official Action, which included a new Election/Restriction directed to new submitted claims 22-24, 26, and 28-31 applicant filed an RCE Amendment After Final Rejection, cancelling claim 25, withdrawing claims 30-31 and adding new independent claim 32 and new dependent claims 33-35.

Based on the foregoing, claims 1, 4-5, and 13-35 are now pending which is inclusive of 3 independent claim (claims 1, 30 and 32) and 23 dependent claims (claims 4-5, 13-29, 31, and 33-35), where claims 4, 19-20, 30-31 are withdrawn claims, and where claims 2-3 and 6-12 and 25 have been cancelled.

## **E. Amendment After Non-Final ( 2 Independent Claims, 18 Dependent Claims and 5 Pending Withdrawn Claims inclusive of 1 Independent Claim and 4 Dependent claims).**

On April 29, 2007 applicant filed an Amendment in response to a Non Final Rejection amending claims 1, 21-24, and 32.

**F. RCE Amendment (3 Independent Claims, 17 Dependent Claims and 5 Pending Withdrawn Claims inclusive of 1 Independent Claim and 4 Dependent Claims)**

On December 7, 2006 applicant in response to a Final Rejection dated August 10, 2006, filed an RCE Amendment, cancelling claim 1, 5, 13-18, 21-24, 26-29, and 32-35, added new claims 36-55 which included 3 independent claims (36, 52, and 55) and 17 dependent claims (claims 37-51, and 53-54)

Based on the foregoing, claims 4, 19-20, 30-31 and 36-55 are now pending which is inclusive of 5 independent claims (claims 30, 32, 36, 52, and 55) and 24 dependent claims (claims 4, 19-20, 31, 37-51, and 53-54), where claims 4, 19-20, 30-31 are withdrawn claims, and where claims 1-3, 5 and 6-18, 21-29 and 32-35 have been cancelled. **Fees due 9 claim in excess of 20 and 2 independent claims in excess of 3.**

**G. Restriction Requirement**

On February 25, 2007, in response to an election restriction requirement, applicant elected with traverse to prosecute claims 36-38, and 46-54. Claims 39-45 and 55 were withdrawn.

**H. Current Amendment**

Applicant has added one new independent claim as a result of this current Amendment. According there are now 21 claims pending in this case inclusive of 6 independent claims (claims 30, 32, 36, 52, 55, and 56) and 14 dependent claims ( claims 4, 19-20, 30-31, 39-45 and 55

**Summary of Pending Claims**

Based on the foregoing, claims 4, 19-20, 30-31and 36-55 are now pending which is inclusive of 6 independent claims (claims 1, 30, 32, 36, 52, and 55) and 14 dependent claims (claims 4, 19-20, 31, 37-38, 46-51, and 53-53), where claims 4, 19-20, 30-31, 39-45 and 55) are withdrawn claims, and where claims 1-3, 5-18, 21-29 and 32-35 have been cancelled. **Fees due 9 claim in excess of 20 and 3 independent claims in excess of 3.**

**In view of the foregoing summary applicant has submitted with this Amendment the missing claim fees which total \$750.00.**

### New Claims 56

New claim 56 is narrower in scope than claims 36 and 55 but similar in construction. New claim 56 does not add new matter, does not require a further search by the examiner, and is directed to a pad that is adhesively attached to a user, classified in class 2, subclass 244. In this regard, no further election/restrictions should be required by the examiner. It should also be noted that no specific body part is claimed therefore there should be no further election of species required by the examiner.

### Objections to the Drawings

The drawing have been objected to under 37 CFR 1.83(a) based on the examiner stating that "the pad being provided with inserts to facilitate exerting pressure points on the skin area of a user" as recited in claim 47 must be shown or the feature must be canceled from the claim. Responsive to this objection applicant has amended sheet 4/6 of the drawings to show the missing feature as discussed in the specification as originally filed at paragraph 0029. In this regard, The specification at paragraph 0029 as originally filed provided the following:

"[0029] Pad 10 can be made of all one material, or a different material may be used in middle layer 15. If desired, cushioning or gel may be used in middle layer 15. Alternatively, a magnetic material may be used in middle layer 15. **In one embodiment of the invention, inserts are positioned in pad 10 so as to apply pressure at desired pressure points on the bottoms of the feet.** In the embodiment of the invention shown in FIG. 10, pad 10 is optionally provided with raised arch area 16. Raised arch area 16 provides for additional support of the foot as well as excellent adhesion of pad 10 to the foot." (Emphasis added.)

Applicant has amended paragraph 0029 to provide the insert with a reference character "15A" and has further amended the drawings (FIG. 10) to be consistent with the specification by showing the insert 15A as discussed in paragraph 0029. Based on the foregoing, which does not add new matter, attorney for applicant respectfully asserts

that the objection to the drawings has been overcome. Applicant further requests approval of this amendment to the drawings is requested.

### **I. Rejections Under 35 USC §102(b)**

#### **A. Claims 36-38 and 52-54**

Claims 36-38 and 52-54 have been rejected under 35 USC §102(b), as being anticipated by Hattori, U.S. 4,553,550, hereinafter called the ***Hattori reference***.

"Anticipation is established only when a single prior art reference discloses expressly or under the principles of inherency, each and every element of the claimed invention." *RCA Corp. v. Applied Digital Data Systems, Inc.*, (1984, CA FC) 221 U.S.P.Q. 385. The standard for lack of novelty that is for "anticipation," is one of strict identity. To anticipate a claim, a patent or a single prior art reference must contain all of the essential elements of the particular claims. *Schroeder v. Owens-Corning Fiberglass Corp.*, 514 F.2d 901, 185 U.S.P.Q. 723 (9th Cir. 1975); and *Cool-Fin Elecs. Corp. v. International Elec. Research Corp.*, 491 F.2d 660, 180 U.S.P.Q. 481 (9th Cir. 1974).

In the present Office Action, the Examiner's rejection is based on the ***Hattori reference*** reference, which fails to show all of the essential elements of the instant invention.

#### **The Hattori Reference**

Before addressing the claim rejections, it would be good first to review what is exactly described in the ***Hattori reference***.

The ***Hattori reference*** describes a personal wearing article comprises a main body, for example, a garment having loops or hooks on the inner surface thereof, a retainer having hooks or loops on the front side thereof engageable with the loops or hooks on the main body, and a pressure sensitive adhesive agent layer provided on the back side of the retainer for sticking the retainer on the human body. (See Abstract)

The *Hattori reference* describes in detail, several personal wearing items as follows:

1. A stocking 6 (FIG. 1);
2. A partial wig 14 (FIG. 6);
3. A wrist watch 15 (FIG. 7);
4. A wrist watch having a strap 16 (FIG. 8);
5. A sweat absorber 18 (FIGS. 9-10);
6. A mask 20 (FIG. 11);
7. An eye bandage (FIG. 12);
8. A bathing suit (FIG. 13)
9. A cylindrical dress (FIG. 19);
10. A brassiere 42 (FIG. 20);
11. A sheet-like thing covering belt 44 (FIG. 21);
12. A breast covering 50 (FIGS. 28 and 30);

All of the claims in the *Hattori reference* are directed to "a breast undergarment".

The *Hattori reference* also states the following:

"The present invention relates to a personal wearing article, which is worn next to the skin, such as stockings, partial wigs, women's bathing suits, women's breast covering undergarments, and women's privates coverings, and more particularly it relates to a personal wearing article comprising fastening means 2 on the inner surface of a personal wearing article main body 1 which is worn next to the skin, mating fastening means 4 fastenable to said fastening means 2 and positioned on the face side of a sheet-like retainer 3 positioned on the body side of the personal wearing article main body 1, and a pressure sensitive adhesive agent layer 5 to be stuck on the wearer's body." (Col. 1, lines 5-17).

In short then, the *Hattori reference* in all of its embodiment disclose a personal wearing article with fastening means on an inner surface thereof and a sheet-like

retainer which has on one of its surfaces a pressure sensitive adhesive agent layer so the retainer can be stuck on a wearer's body and a mating fastening means on its other surface to fasten the personal wearing article to the retainer, once it has been attached to the body of the wearer.

Now turning to how the examiner describes what is taught by the *Hattori reference*, we find the following description in paragraph 4 of the Office Action:

"In regard to claim 36, Hattori teaches a protective attachment comprising a pad (3) formed of a shock absorbing cushioning material. The pad (3) including a top surfaced (5) and a bottom surface (10). The bottom surface is at least partially covered with a layer of thistle cloth (10) to facilitate removably adhering a complimentary layer of thistle cloth (8) on a ground contacting protective base (1)."

From the foregoing, it is best understood that the examiner is asserting that the pad (3) is the retainer item (3) as described in the *Hattori reference* and that the ground contacting protective base (1) is the personal wearing article (1) as described in the *Hattori reference*. Based on this understanding the following arguments are presented for consideration by the examiner.

#### a. Claim 36

Claim 36 as amended emphasize the patentable novelty thereof and specifies the following:

"36. A protective attachment, comprising:

a skin engaging pad formed of a shock absorbing cushioning material; and  
wherein said pad includes a top surface and a bottom surface; and  
wherein said bottom surface is at least partially covered with a layer of thistle cloth to facilitate removably adhering to a complimentary layer of thistle cloth on a ground contacting protective base."

First, none of the retainers (3) described by the *Hattori reference* are described as "a pad formed of a shock absorbing material". For example the *Hattori reference* describes the retainer (3) as follows: "[T]he numeral 3 denotes a retainer which, as shown in FIG. 4, has mating fastening means 4 in the form of an infinite number of liner rods formed thereon in a nap raising fashion and having front end hooks 10, said retainer also having a pressure sensitive adhesive agent layer 5 applied to the back side thereof for sticking said retainer 3 on the human body 12. As shown in FIGS 4d and 4e, the retainer 3 may comprise a belt-like synthetic resin sheet 3a having a pressure sensitive adhesive agent layer 5 applies thereto, and a base fabric 9 whose area is smaller than that of said sheet 3a and which is heat sealed thereto, so as to sufficiently increase the area for sticking the retainer 3 on the body 12 as compared with the mating fastening means 4 provided on the base fabric 9, thereby increasing the retaining strength of the retainer 3." Col 5, lines 38-53.

Based on the foregoing, claim 36 patentably distinguish over the *Hattori reference*.

Finally, none of the personal wearing items as described by the *Hattori reference* are described as "a ground contacting protective base". Dresses, stockings, brassieres, sheet-like covering belts, bathing suits, and the like are composed of thin fabric like materials and are not intended as "a ground contacting protective base." For this reason alone, claim 36 is not anticipated by the *Hattori reference*.

#### **b. Claim 37**

Claim 37 as originally filed emphasize the patentable novelty thereof and specifies the following:

"37. The protective attachment according to claim 36, wherein said protective base is a protective shell to protect the skin area of a user from direct contact with the ground."

With respect to claims 37, the examiner has stated that the *Hattori reference* discloses "a protective base which is a protective shell to protect the skin area of a user from direct contact with the ground." To support this position, the examiner points to all of the figures 1-42 of the *Hattori reference*. Applicant respectfully disagrees that the *Hattori reference* teaches such a structure on the following grounds:

Paragraph 0044 of the present application provides the following:

"[0044] Yet another alternative embodiment of the invention is shown in FIGS. 14, 15, 16 and 17. This embodiment of the invention includes pad 60 and one of the protective shells shown in FIG. 15, 16 or 17. In some sports, such as roller blading or skate boarding, it is desirable to have additional padding for protection against injury. The protective shells shown in FIGS. 15 through 17 provide additional padding for protection against injury. However, because the cost of manufacturing the protective shells may be higher than the cost of manufacturing pad 60, it is desirable that pad 60 be disposable after one or two uses, while the protective shells may be used many times."

The specification therefore makes it clear that "a protective shell" as shown in FIGS. 15-17 is an article that is intended to "protect against injury" and not merely an article of personal wear for covering the body of a user.

Turning now to the comments of the examiner, the examiner in rejecting claim 37 has made it clear that "a protective base" as used in describing what is taught by the *Hattori reference* is the personal wearing article (1) and not the retainer (3). Therefore attorney for applicant would argue that none of the personal wearing item (Dresses, stockings, brassieres, sheet-like covering belts, bathing suits, and the like are composed of "a protective shell material" whose function is to "protect the skin area of a user from direct contact with the ground."

Based on the foregoing, the novel features of the present invention are not

disclosed, nor suggested by the ***Hattori reference*** in that the ***Hattori reference*** does not disclose, nor suggest a " wherein said protective base is a protective shell to protect the skin area of a user from direct contact with the ground. " Therefore claim 37 patentably distinguish over the ***Hattori reference***.

**c. Claim 38**

Claim 38 as originally filed emphasize the patentable novelty thereof and specify the following:

"38. The protective attachment according to claim 37, wherein said top surface is completely covered with a layer of adhesive."

Since claim 38 depends from claims 36 and 37, claim 38 patentably distinguish over the ***Hattori reference*** based upon the same arguments as present earlier relative to claims 36-37.

In summary then, while the ***Hattori reference*** may teach a personal wearing item which includes a retainer for attaching the article to the skin of a user, the ***Hattori reference*** does not disclose, nor suggest, the novel features of the present invention as claimed. Therefore, claims 36 as amended and claims 37-38 as originally filed, patentably distinguish over the ***Hattori reference***.

**c. Claim 52**

Claim 52 as originally filed emphasize the patentable novelty thereof and specify the following:

"52. (Previously Presented) A protective attachment, comprising:

    a first layer of a shock absorbing cushioning material having a top surface and a bottom surface;

    wherein said bottom surface is at least partially covered with a layer of

thistle cloth; and

a ground contacting protective base having an inner surface at least partially covered with another layer of thistle cloth to facilitate removably attaching said ground contacting protective base to said bottom surface."

With respect to claims 52, the examiner has stated that the *Hattori reference* teaches "a protective attachment comprising a first layer of shock absorbing cushioning material (3) having a top surface (5) and a bottom surface (10). The bottom surface is at least partially covered with a layer of thistle cloth (10). A ground contacting protective base (1) having an inner surface at least partially covered with another layer of thistle cloth (8) to facilitate removably attaching said ground contacting protective base to the bottom surface. "

From the foregoing, it is best understood that the examiner is asserting that the shock absorbing cushioning material (3) is the retainer item (3) as described in the *Hattori reference* and that the ground contacting protective base (1) is the personal wearing article (1) as described in the *Hattori reference*. Based on this understanding the following arguments are presented for consideration by the examiner.

First, none of the retainers (3) described by the *Hattori reference* are described as "a first layer of a shock absorbing cushioning material". For example the *Hattori reference* describes the retainer (3) as follows: "[T]he numeral 3 denotes a retainer which, as shown in FIG. 4, has mating fastening means 4 in the form of an infinite number of liner rods formed thereon in a nap raising fashion and having front end hooks 10, said retainer also having a pressure sensitive adhesive agent layer 5 applied to the back side thereof for sticking said retainer 3 on the human body 12. As shown in FIGS 4d and 4e, the retainer 3 may comprise a belt-like synthetic resin sheet 3a having a pressure sensitive adhesive agent layer 5 applies thereto, and a base fabric 9 whose area is smaller than that of said sheet 3a and which is heat sealed thereto, so as to sufficiently increase the area for sticking the retainer 3 on the body 12 as compared with

the mating fastening means 4 provided on the base fabric 9, thereby increasing the retaining strength of the retainer 3." Col 5, lines 38-53.

Based on the foregoing, claim 52 patentably distinguish over the *Hattori reference*.

Finally, none of the personal wearing items as described by the *Hattori reference* are described as "a ground contacting protective base". Dresses, stockings, brassieres, sheet-like covering belts, bathing suits, and the like are composed of thin fabric like materials and are not intended as "a ground contacting protective base." Moreover, none of the personal wearing items as described by the *Hattori reference* are adapted to be attached to the bottom of "a first layer of a shock absorbing cushioning material". For this reason alone, claim 52 is not anticipated by the *Hattori reference*.

#### **d. Claim 53**

Claim 53 as originally filed emphasize the patentable novelty thereof and specify the following:

"53. The protective attachment according to claim 52, wherein said protective base is a protective shell to protect the skin area of a user from direct contact with a ground surface."

With respect to claims 53, the examiner has stated that the *Hattori reference* discloses "a protective base which is a protective shell to protect the skin area of a user from direct contact with the ground." To support this position, the examiner points to all of the figures 1-42 of the *Hattori reference*. Applicant respectfully disagrees that the *Hattori reference* teaches such a structure on the following grounds:

Claim 53 is a dependent claim, which depends from claim 52, therefore claim 53 patentably distinguish over the *Hattori reference* based on the same argument

presented relative to claim 52 and claim 37. More specifically, the *Hattori reference* does not disclose, nor suggest a "wherein said protective base is a protective shell to protect the skin area of a user from direct contact with a ground surface." Therefore claim 53 patentably distinguish over the *Hattori reference*.

**e. Claim 54**

Claim 54 as originally filed emphasize the patentable novelty thereof and specify the following:

"54. The protective attachment according to claim 53, further comprising:  
a complimentary layer of adhesive disposed on said top surface to facilitate attaching said first layer to the skin area of the user."

Since claim 54 depends from claims 52 and 53, claim 54 patentably distinguish over the *Hattori reference* based upon the same arguments as present earlier relative to claims 52-53.

In summary then, while the *Hattori reference* may teach a personal wearing item which includes a retainer for attaching the article to the skin of a user, the *Hattori reference* does not disclose, nor suggest, the novel features of the present invention as claimed. Therefore, claims 36 as amended and claims 37-38 as well as claims 52-54 as originally filed, patentably distinguish over the *Hattori reference*.

**B. Claims 36 and 48-51**

Claims 36 and 48-51 have been rejected under 35 USC §102(b), as being anticipated by Mogonye, U.S. Patent No. 4,924,608, hereinafter called the *Mogonye reference*.

In the present Office Action, the Examiner's rejection is based on the *Mogonye reference*, which fails to show all of the essential elements of the instant invention.

### **The Mogonye Reference**

Before addressing the claim rejections, it would be good first to review what is exactly described in the ***Mogonye reference***.

The ***Mogonye reference*** describes a safety shoe for use in working on slippery surfaces has an upper portion secured to a flexible rubber sole. A flexible fastener secured to the bottom of the sole has hooked elements which removably secure a fibrous sole pad thereon. The juncture of the upper and sole is overlapped by a rubber strip element which secures the juncture and provides improved appearance. A conventional toe guard may be affixed to the perimeter of the toe portion of the strip element. A cushioned inner pad is contained within the shoe on the top surface of the sole. The preferred sole pad is formed of interlocked polyester or nylon fibers to provide a long-lasting pad which is not appreciably depreciated by floor cleaning compounds and provides traction on the slippery surface. The sole pads are of a material conventionally used in cleaning floors and in stripping wax from floors. The sole pads are secured by a pressing them onto the bottom of the shoe and are removed by peeling them off. They may also be provided in sets ranging in thickness and density, and varying fiber materials to adapt to various types of working conditions. In addition to providing the desired traction on slippery surfaces, the sole pads may be used to exert concentrated scrubbing action by foot motion.

More specifically, the ***Mogonye reference*** teaches a safety shoe 10 with a conventional upper 11 secured to a flexible rubber bottom or outer sole 12. One or more strips of a flexible fastener material 18 comprised of small hooks is secured to the bottom surface of the outer sole 12 by means of a suitable water resistive flexible adhesive or epoxy. A flexible sole pad 21 of non-woven synthetic fibrous material is cut to the plan shape of the sole 12. The ***Mogonye reference*** then provides "a preferred sole pad material is formed of material such as that manufactured and sole as floor maintenance pads for use on power driven floors maintenance machines conventionally used in cleaning floors and in stripping wax from wax floors.... The preferred pad is

formed of interlocked polyester or nylon fibers to provide a long lasting pad which is not appreciably depreciated by floor cleaning compounds. ....In use the, worker presses the replaceable sole pad 21 onto the fastener strip 20 on the bottom of each shoe and puts the shoes on."

### 1. Claim 36

With respect to 36, the examiner states that the **Mogonye reference**, "teaches a protective attachment comprising a pad (12) formed of a stock absorbing cushioning material. The pad includes a top surface and a bottom surface. The bottom surface is at least partially covered with a layer of thistle clothe (18, 20) to facilitate removably adhering a complimentary layer of thistle cloth (21) on a ground contacting protective base (21)." Attorney for applicant respectfully disagrees on the following ground.

From the foregoing, it is best understood that the examiner is asserting that the shock absorbing cushioning material (12) is the outer sole of the shoe (10) as described in the **Mogonye reference** and that the ground contacting protective base (21) is the flexible sole pad (21) which is composed of the same material as floor maintenance pads. Based on this understanding the following arguments are presented for consideration by the examiner.

The **Mogonye reference** is very specific in providing that the bottom of the outer sole (12) is provided with a flexible fastener material (18) which is fixedly secured to the bottom surface of the outer sole by an adhesive or epoxy. The **Mogonye reference** is also very specific in providing that outer surface of the fastener (18) is comprised of a plurality of small hooks (20). Conversely, when describing the flexible sole pad (21), the **Mogonye reference** describes a completely different type of material namely that of a non-woven synthetic fibrous material manufactured and sole as floor maintenance pads.

Based on the foregoing, the ***Mogonye reference*** fails to teach or disclose “wherein said bottom surface is at least partially covered with a layer of thistle cloth to facilitate removably adhering to a complimentary layer of thistle cloth on a ground contacting protective base.”

Therefore claim 36 as amended patentably distinguish over the ***Mogonye reference***.

## **2. Claim 37**

The examiner mentions claim 37 in paragraph 5 of the Office Action but does not specifically reject claim 37 as being anticipated by the ***Mogonye reference***. Attorney for applicant will assume this is an oversight on the part of the examiner since the examiner does specifically state the following:

“In regard to claim 37, Mogonye teaches a protective base as being a protective shell to protect the skin area of a user from direct contact with the ground”, citing column 2, lines 58-63.

With respect to what is taught by the ***Mogonye reference*** at column 2, lines 58-63 we find the following:

“A still further object of this invention is to provide footwear for use while working on slippery surfaces which has a replaceable sole pad of fibrous material which is simple in construction, economical to manufacture, and safe, rugged and durable in use. “ Clearly this is not “a protective shell” nor is it intended “to protect the skin area of a user from direct contact with the ground” because it replaceable sole pad (21) is attached directly to the outer sole (12) by its fastener strip (18).

Based on the foregoing, claim 37 patentably distinguish over the ***Mogonye reference***.

### 3. Claim 48

Claim 48 is a dependent claim which depends from claims 36 and 37. Accordingly, claim 48 patentably distinguish over the *Mogonye reference* based upon the same arguments as present above relative to claims 36 and 37 respectively. Moreover, it is clear that the *Mogonye reference* does not teach nor disclose "a pad...provided with a raised arch area" since the examiner has admitted that the pad (12) is the outer sole of the shoes (10), which clearly is flat in the arch area of the shoe (10).

Based on the foregoing, claim 48 patentably distinguish over the *Mogonye reference*.

### 4. Claims 49-50

Claims 49-50 patentably distinguish over the *Mogonye reference* based on the same arguments as presented earlier herein relative to claims 36 and 37.

### 5. Claim 51

With respect to claim 51, the examiner has stated that the *Mogonye reference* Teaches "the pad has an inner cushioned area with an outer adhesive strip which surrounds said cushioned area, citing column 3, lines 66-68.

Column 3, lines 66-68 of the *Mogonye reference* provides the following:

"The fastener 18 may be a single piece of material cut to the plan shape of the sole 12 to completely cover the sole."

In short then, there is absolutely no support in the *Mogonye reference* for "a pad...wherein the pad has an inner cushioned area with an outer adhesive strip which surrounds said cushioned area."

Based on the foregoing, claim 51, patentably distinguishes over the *Mogonye reference*.

## **II. Rejections Under 35 USC §102(e)**

Claims 36 and 37 have been rejected under 35 USC §102(e), as being anticipated by McCrane, U.S. Patent No. 6,029,273, hereinafter called the *McCrane reference*.

In the present Office Action, the Examiner's rejection is based on the *McCrane reference* which fails to show all of the essential elements of the instant invention.

### **The McCrane Reference**

The teaches a protective device (16) comprised of a cushioning pad (18), replaceable wear cap (20) and fastening structure (22) which is releasably carried between the wear cap and cushioning pad. The protective device (16) is adapted to be strapped about the knee of a participant in sports such as inline skating, skateboarding, roller skating and other active sports where falls onto hard pavement or other surfaces can be expected. ..The cushioning pad (18) is formed of a yieldable and force-absorbing material such as a foamed polymer, a felt material, or a combination of foamed, felt or other similar elastic materials. The pad (18) is releasably attached to the user's knee by means of elongated straps (24-30) which are secured to the edges of the pad by means such as sewing. At the opposite ends of the straps, strips (32, 34) of complementary hook and loop fasteners are secured for releasably attaching the strap ends together in loops around the knee. The replaceable wear cap (20) is formed of a suitable material which is resistant to abrasion and which also has a smooth outer surface to enable the cap to slide along a hard pavement surface. Fastening structure (22) is comprised of complementary layers of hook and loop fasteners. The layers are carried between inner surface 36 of the wear cap (20) and outer surface 38 of the cushioning pad (18). A first layer (40) of the loop material is secured by suitable means, such as adhesive, to the inner surface of the wear cap (20). Typically the loop material comprises yarn loops (41) formed in a pile on a fabric backing strip. A second layer, comprised of four segments (42-48), of the complementary hook material is secured by means such as adhesive to the outer surface of the cushioning pad (18). See Col 3, lines 61 et seq.

### **1. Claim 36**

With respect to claim 36, the examiner has stated that the *McCrae reference*. Teaches a protective attachment comprising a pad (18) formed of a shock absorbing cushioning material. The pad (18) including a top surface and a bottom surface. The bottom surface is at least partially covered with a layer of thistle cloth (22) to facilitate removably adhering a complimentary layer of thistle clothe (22) on a ground contacting protective base (20), citing column 4, lines 13-16.

Since the *McCrae reference* provides that the pad (18) is releasably attached to the user's knee by means of elongated straps (24-30) which are secured to the edges of the pad by means such as sewing, it is clear that the *McCrae reference* fails to teach or disclose "a skin adhering pad formed of a shock absorbing cushioning material..."

Based on the foregoing, claim 36 patentably distinguish over the *McCrae reference*.

### **2. Claim 37**

With respect to claim 37, the examiner has stated that the *McCrae reference*. Teaches said protective base (20) being a protective shell to protect the skin area of a user from direct contact with the ground, citing column 4, lines 26-38.

Claim 37 depends from claim 36; therefore claim 37 patentably distinguish over the *McCrae reference* under the same arguments presented above relative to claims 36 as amended.

Based on the foregoing, claim 37 patentably distinguish over the *McCrae reference*.

### **III. Rejections Under 35 USC §103**

#### **A. Claim 46**

Claim 46 has been rejected under 35 USC §103 as being unpatentable over the ***McCrane reference*** in view of Humphreys, U.S. Patent No. 5,233,768, hereinafter called the ***Humphreys reference***.

#### **The Humphreys reference**

The ***Humphreys reference*** discloses an insole for a shoe, having a three layer design. A top, cushioning layer for the comfort of the user. A center layer having a distinct pattern of lengthwise strips of material, these lengthwise strips of material being a north pole oriented strip, a dielectric lengthwise strip, and a south pole oriented lengthwise strip. Further, each of these lengthwise magnetic strips are formed of a top layer of north pole oriented material, covering a layer of dielectric material, and then, a bottom layer of south pole oriented material covering the bottom of the dielectric material. These strips of magnetic material are installed alternately in the center layer, creating a pattern of north pole oriented strip, bordering a dielectric strip, bordering a south pole oriented strip. A bottom cushioning layer, having a plurality of protrusions on the bottom, provides additional cushioning effects to the user.

Claim 46 is a dependent claim depending from claim 36 as amended. Therefore since claim 36 as amended patentably distinguishes over the ***McCrane reference***. Then claim 46 patentably distinguishes over the ***McCrane reference*** under the same argument present herein earlier, whether the ***McCrane reference*** is taken alone or in combination with the ***Humphreys reference***.

#### **B. Claim 47**

Claim 47 has been rejected under 35 USC §103 as being unpatentable over the

**Mogonye reference** in view of Buchsenschuss, U.S. Patent No. 5,664,342, hereinafter called the **Buchsenschuss reference**.

The **Buchsenschuss reference** discloses an insole having profiles on its upper surface, for enabling a massaging effect on the tissue of a foot. According to the invention the profiles, formed in the shape of knobs (2a), are arranged in special areas (2) of the sole area, these special areas being selected in accordance with aspects of reflex zone therapy in order to activate certain organs.

Claim 47 is a dependent claim depending from claim 37 as originally filed, which in turn depends from claim 36 as amended. Therefore since claim 36 as amended patentably distinguishes over the **Mogonye reference**, then claim 47 patentably distinguishes over the **Mogonye reference** under the same argument present herein earlier relative to claims 36-37, whether the **Mogonye reference** is taken alone or in combination with the **Buchsenschuss reference**.

### Conclusion

Attorney for Applicant has carefully reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance

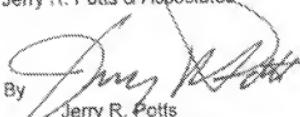
prosecution of this case to finality, the Examiner is invited to call the undersigned  
Jerry R. Potts, Esq. at the below-listed telephone number.

Dated: 07/17/07

Respectfully submitted,

Jerry R. Potts & Associates

By



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